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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,841	03/19/2004	Lawrence E. Gebhart	461987-024	7527
42101	7590	01/08/2009		
THOMPSON HINE LLP Intellectual Property Group P.O. BOX 8801 DAYTON, OH 45401-8801				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
01/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,841

**Applicant(s)**

GEBHART ET AL.

**Examiner**

WILLIAM T. LEADER

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-31, 33-35 and 38-48 is/are pending in the application.  
4a) Of the above claim(s) 1-11, 13-20 and 41-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-31, 33-35, 38-40 and 44-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Receipt of the papers filed on September 30, 2008, is acknowledged. Claims 1-11, 13-31, 33-35 and 38-48 are pending. Claims 1-11, 13-20 and 41-43 remains withdrawn from consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 21-31, 33-35, 38-40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Kempen et al (6,818,115) in view of the admitted prior art and Botts et al (5,776,327) and further in view of Gagnon et al (5,616,246) for the reasons of record.
4. Claims 44-46 and 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over van Kempen et al (6,818,115) in view of the admitted prior art and Botts et al (5,776,327) and further in view of Gagnon et al (5,616,246) as applied to claims 21-31, 33-35, 38-40 and 47 above, and additionally in view of Wilson et al (2005/0178667) for the reasons of record.

### ***Response to Amendment***

5. The declaration under 37 CFR 1.132 filed September 30, 2008 is insufficient to overcome the rejection of the claims as set forth in the last Office action.

As explained in MPEP section 716.02(d), whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). The evidence submitted by applicant is not considered to show unexpected results which are commensurate in scope with the claims.

6. Applicant’s experimental results were obtained using only a single test apparatus using workpieces having only a single configuration. The workpiece was a 450 mm x 600 mm stainless steel panel. Thus, the workpiece had a completely flat surface. Claim 21, however, recites a workpiece having a major surface. There is no requirement in the claim that the workpiece be flat. The workpiece could, for example, be of a corrugated or undulating configuration with some portions closer to the anode and other regions further away from the anode. Or the workpiece could be a solid cylindrical object with the major surface being the cylindrical portion and the two ends being minor surfaces. It is not apparent that the results based on a flat panel extend to workpieces of other configurations.

7. Additionally, from the figures in the declaration and specification, it appears that the anode chamber is of a size greater than the workpiece. Thus, a portion of the anode structure is located opposite the entire surface of the workpiece. It is not apparent that the results obtained extend to other arrangements where, for example, the anode opposes only a small portion of the major surface of the workpiece.

8. At page 4 of the Declaration, it is stated that a comparison of the results of tests 5DH-II and 5DH-IV show that the porous cloth greatly improved the coefficient of variation of the workpiece. However, no description of the porous cloth or its characteristics is provided. The porous cloth is described in paragraph [0076] in the pre-grant publication of the application. One cloth had a porosity of 2-4 cubic feet. Another cloth had a porosity of 20-30 cubic feet per minute. Claim 21 recites a porous cloth broadly. It is not apparent that the results obtained extend to all types of porous cloths included within the scope of the claims.

9. The apparatus used to carry out the tests had a specific geometric configuration. Electrolyte was fed through eductors which were horizontally positioned. The electrolyte was directed to the flow-directing surface of a flow dampening member which was curved to redirect the flow in a vertical direction. The flow dampening member was coextensive with the anode chamber and had a length which was larger than that of the workpiece. As stated in paragraph [0079] of applicant's specification, the flow dampening member may have a variety of shapes. It is not apparent that the results of the single geometry utilized to generate the data presented in the declaration extend to other geometrical arrangements.

10. At page 2 of the Declaration, it is stated that the cloth anode bag shown in the Gagnon reference does not correspond to the claimed porous cloth that is in planar relationship to the major surface of the workpiece. This statement is not considered to be correct. The arrangement of the apparatus used to carry out the process of Gagnon is shown in figure 4 and described at column 16, lines 38-58. As shown in figure 4, the substrate 126 to be plated has a planar surface. Anode 116 also has a planar surface which is oriented to be in parallel relationship with the

surface of the substrate. The anode bag is shown as element 124 which is represented by a solid line. The line is parallel to the surface of the anode and also parallel to the surface of the substrate. Thus, the limitation recited in applicant's claim 21 that the porous cloth is oriented in a planar parallel relationship to the major surface of the workpiece is met by the arrangement of Gagnon.

#### ***Response to Arguments***

11. Applicant's arguments filed September 30, 2008, have been fully considered but they are not persuasive. At page 3 of the Remarks, applicant notes that the invention is directed to a different problem than the problem addressed by the use of an anode sock. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

12. At pages 3 and 4 of the Remarks, applicant refers to the test results presented in the specification and in the declaration. For the reasons given above, the results are not considered to be commensurate in scope with the claims.

#### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/  
Primary Examiner, Art Unit 1795

/William Leader/  
January 2, 2008